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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,683	11/24/2003	Francis Pruche	05725.1256-00	3211
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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER VENKAT, JYOTHSNA A	
			ART UNIT 1615	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/718,683	Applicant(s) PRUCHE ET AL.	
	Examiner JYOTHSNA A. VENKAT Ph. D	Art Unit 1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-69 is/are pending in the application.
- 4a) Of the above claim(s) 58-65 and 67 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-57, 66, 68 and 69 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/6/06 and 11/24/03</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

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Receipt is acknowledged of election filed on 5/9/07 and IDS filed on ~~7/6/06~~ and

11/24/03. Claims 1-69 are pending in the application and the status of the application is as follows:

Priority

If applicant desires to claim the benefit of a prior-filed application under 35 U.S.C. 119(e), Applicant must provide a certified English translation of the provisional applications. Further, a specific reference to the prior-filed application in compliance with 37 CFR 1.78(a) must be included in the first sentence(s) of the specification following the title or in an application data sheet. For benefit claims under 35 U.S.C. 120, 121 or 365(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of the applications.

If the instant application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the specific reference must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be submitted during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A benefit claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed benefit claim under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

If the reference to the prior application was previously submitted within the time period set forth in 37 CFR 1.78(a), but not in the first sentence(s) of the specification or an application data sheet (ADS) as required by 37 CFR 1.78(a) (e.g., if the reference was submitted in an oath or declaration or the application transmittal letter), and the information concerning the benefit claim was recognized by the Office as shown by its inclusion on the first filing receipt, the petition under 37 CFR 1.78(a) and the surcharge under 37 CFR 1.17(0 are not required.

Applicant is still required to submit the reference in compliance with 37 CFR 1.78(a) by filing an amendment to the first sentence(s) of the specification or an ADS. See MPEP § 201.11.

Election/Restrictions

Applicant's election with traverse of group I in the reply filed on 9/7/07 is acknowledged. The traversal is on the ground(s) that that examining a composition and a process/method of using the composition (i.e., Groups I and Groups II-IV) would not impose a serious burden on the Examiner, since a search of the composition would overlap the search for the process/method given the classification (class 424) and applicants submit no serious burden would exist in light of the requirement of rejoinder. See M.P.E.P. § 821.04. This is not found persuasive because it is search burden to examine the composition claims and distinct method of use claims. Art anticipating or rendering obvious composition claim would not anticipate or render obvious method of use claims. Applicants are also notified that the rejoinder is at the time of allowance and not before allowance and not before allowance and the process claims would be rejoined, if they depend on the composition claims that are found allowable. Additionally restriction between groups II-IV is in compliance with MPEP 806.05(h).

The requirement is still deemed proper and is therefore made FINAL.

Claims 58-65 and 67 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 9/7/07.

Claims 1-57, 66 and 68-69 are pending in the application and the status of the application is as follows:

Information Disclosure Statement

In the IDS dated 7/6/07 the foreign documents have been crossed out since there are no references or abstracts corresponding to references that are not in English. The only abstracts that are present are JP 11092347 and JP 2002332222. These documents are not cited on IDS.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-57, 66 and 68-69 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. **This is written description rejection.**

All the claims are rejected since there is no description in the specification for the species in claim 19 belonging to dye precursor "chosen from compounds comprising at least one aromatic ring comprising at least two hydroxyl groups borne by two successive carbon atoms of the at least one aromatic ring".

This is a "written description" rejection, rather than an enablement rejection under 35 U.S.C. 112, first paragraph. *Vas-Cath Inc. V. Mahurka*, 19 USPQ2d 1111, states that applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he

or she was in possession of the invention. The invention, for purposes of the “written description” inquiry, is “*whatever is now claimed*” (see page 1117).

A description of a genus may be achieved by means of a recitation of a representative number of species falling within the scope of the genus or of a recitation of structural features common to the members of the genus, which features constitute a substantial portion of the genus. *Regents of the University of California v. Eli Lilly & Co.*, 119 F3d 1559, 1569, 43 USPQ2d 1398, 1406 (Fed. Cir. 1997). In *Regents of the University of California v. Eli Lilly* (43 USPQ2d 1398-1412), the court held that a generic statement which defines a genus of nucleic acids by only their functional activity does not provide an adequate written description of the genus. The court indicated that, while applicants are not required to disclose every species encompassed by a genus, the description of the genus is achieved by the recitation of a representative number of species falling within the scope of the claimed genus. At section B (1), the court states “An adequate written description of a DNA ... requires a precise definition, such as by structure, formula, chemical name, or physical properties, not a mere wish or plan for obtaining the claimed chemical invention”. Hence, an adequate written description of the ingredients requires more than a mere statement that it is part of the invention and reference to a potential method for isolating it.

The disclosure of a single disclosed species may provide an adequate written description of a genus when the species disclosed is representative of the genus. However, the present claim encompasses numerous species that are not further described. One of skill in the art would not recognize from the disclosure that the applicant was in possession of the genus drawn to “all the derivatives recited in claim 19 for the dye precursors. There is no description for derivatives of

“3,4-dihydroxyphenylalanine derivatives thereof, 2,3-dihydroxyphenylalanine derivatives thereof, 4,5-dihydroxyphenylalanine derivatives thereof, 4,5-dihydroxyindole derivatives thereof, 5,6-dihydroxyindole derivatives thereof, 6,7-dihydroxyindole derivatives thereof, and 2,3-dihydroxyindole derivatives thereof”.

The courts have stated:

“To fulfill the written description requirement, a patent specification must describe an invention and do so in sufficient detail that one skilled in the art can clearly conclude that the inventor invented the claimed invention. *Lockwood v. American Airline, Inc.*, 107 F.3d 1565,1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997); *In re Gosteli* 872 F.2d 1008,1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989) (“ [T] he description must clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed.”). Thus an applicant complies with written description requirement “ by describing the invention, with all its claimed limitation, not that which makes it obvious,” and by using “ such descriptive means as words, structures, figures, diagrams, formulas, etc., that set forth the claimed invention.” *Lockwood v. American Airline, Inc.*, 107 F.3d at 1572, 41 USPQ2d at 1966; *Regents of the University of California v. Eli Lilly &Co.*, 43 USPQ2d 1398.

The description requirement of the patent statute requires a description of an invention, not an indication of a result that one might achieve if one made that invention. See *In re Wilder* 736 F.2d 1516, 1521, 222 USPQ 369, 372-373 (Fed. Cir. 1984) . Accordingly, it is deemed that the specification fails to provide adequate written description for the genus “ derivatives ” belonging to dye precursors recited in all the independent claims and does not reasonably convey

to one skilled in the relevant art the inventor(s), at the time the application was filed has possession of the entire scope of the invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3-11, 19, 33 , 39 and 69 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

There is no charge for HCO_3^- . Bicarbonate is an anion and it has negative charge.

The expression "derivatives there of (at all occurrences) is without metes and bounds. Recourse to the specification does not define these compounds.

The expression " with which at least one distribution orifice may be selectively place in communication depending on the configuration of" the device in claim 39 is ambiguous. What is this device?

What is the reason for using dye precursor, when the cosmetic product is product for nails, eyebrows and eyelashes? Dye precursors are normally used for coloring hair. Competent documentation that the dye precursors are also used for coloring eyebrows, eyelashes and nails would be careful consideration.

Claim Rejections - 35 USC § 103

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any

evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-41, 50-53, 66 and 68-69 are rejected under 35 U.S.C. 103(a) as being obvious over the combination of U. S. Patents 6,953,486 ('486) and 6,736,861('861).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

Patent '486 teaches dyeing compositions also known as coloring compositions for coloring the keratin (skin or hair). See the abstract. Patent '486 teaches coloring using dye precursor at col.3, line 56 to col.4, line 25 and the claimed catalytic system at col.2, line 51 to

col.col.3, line 55. Patent at col.5, ll 36-48 teaches plant extracts claimed in claims 20-21. Patent at col.6, ll 53-68 teaches physiologically acceptable medium claimed in claims 25-28 and teaches the weight percent at col.7, ll 7-11 (claims 29-31). Patent at col.8, ll 23-42 teaches that the composition can be packed in two discrete containers or it can be packed in a single compartment. See the examples and see also claims. The difference between the patent and instant application is patent '486 does not teach composition also having an acidic composition or basic composition. However, patent '861 teaches color hair using acidic composition and basic composition. See claim 1 and see col.3, line 10 through col.4, line 41.

Accordingly it would be obvious to one of ordinary skill in the art at the time the invention was made to prepare hair coloring compositions of patent '486 and add to the compositions an acidic composition and basic composition of patent '881. It is prima facie obvious to combine two compositions which have been used individually for the same purpose since the idea of combining the ingredients flows logically from the art.

Claims 1-41, 50-53, 66 and 68-69 are rejected under 35 U.S.C. 103(a) as being obvious over the combination of WO 02/30375 ('375) and 6,736,861('861).

U. S. Patent 6,953,486 is the English equivalent for WO 02/30375. Examiner is relying on the disclosure of the patent.

Patent '486 teaches dyeing compositions also known as coloring compositions for coloring the keratin (skin or hair). See the abstract. Patent '486 teaches coloring using dye precursor at col.3, line 56 to col.4, line 25 and the claimed catalytic system at col.2, line 51 to col.col.3, line 55. Patent at col.5, ll 36-48 teaches plant extracts claimed in claims 20-21. Patent at col.6, ll 53-68 teaches physiologically acceptable medium claimed in claims 25-28 and teaches

the weight percent at col.7, ll 7-11 (claims 29-31). Patent at col.8, ll 23-42 teaches that the composition can be packed in two discrete containers or it can be packed in a single compartment. See the examples and see also claims. The difference between the WO document and instant application is WO document does not teach composition also having an acidic composition or basic composition. However, patent '861 teaches color hair using acidic composition and basic composition. See claim 1 and see col.3, line 10 through col.4, line 41.

Accordingly it would be obvious to one of ordinary skill in the art at the time the invention was made to prepare hair coloring compositions of WO document and add to the compositions an acidic composition and basic composition of patent '881. It is prima facie obvious to combine two compositions which have been used individually for the same purpose since the idea of combining the ingredients flows logically from the art.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-41, 50-53, 66 and 68-69 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-32 of U.S. Patent No. 6,953,486 in view of 6,736,861 ('861). The instant application and the patent are claiming compositions using the same dyeing precursor and also catalytic system. Patent does not claim compositions having acidic composition and basic composition. See the explanation under 103.

Claims 1-41, 50-53, 66 and 68-69 are directed to an invention not patentably distinct from claims 1-32 of commonly assigned 6,953,486. Specifically, for the reason stated under 103 and obviousness type double patenting rejection.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned 6,953,486, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly

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assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT Ph. D whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30:1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL WOODWARD can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JYOTHSNA A. VENKAT/ Ph. D
Primary Examiner
Art Unit 1615
